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09/810,159	03/19/2001	Shuwu Wu	06975-099001	9046

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EXAMINER

NGUYEN, TRONG NHAN P

ART UNIT	PAPER NUMBER
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2152

DATE MAILED: 02/11/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/810,159

Applicant(s)

WU ET AL.

Examiner

Jack P Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 9/24/04.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-39 is/are pending in the application.
- 4a) Of the above claim(s) 27-36 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-26 and 37-39 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This action is in response to Applicant's amendment filed on 9/24/04. Claims 1-39 are being examined.

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Group 1: Claims 1-26 & 37-39 are drawn to a method for establishing a text instant messaging session connection between participants in 709, subclass 227.
- II. Group 2: Claims 27-36 are drawn to a method for determining the availability of the sender to participate in voice communication with the recipient and enabling the recipient to perceive to availability of the sender to participate in voice communication with the recipient in response to delivery of the text instant message in class 709, subclass 205.

Inventions I and II are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. Invention I has a separate utility such as in a system lacking for determining the availability of the sender to participate in voice communication with the recipient and enabling the recipient to perceive to availability of the sender to participate in voice communication with the recipient in response to delivery of the text instant message. Invention II has a separate utility such as in a system lacking establishing a text instant messaging session connection between participants. See MPEP § 806.05(d).

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These inventions are distinct for the reasons given above, and the search required for each Group is different and not co-extensive for examination purpose. For example, the searches for the two inventions would not be co-extensive because these groups would require different searches on PTO's classification class and subclass as following:

(a) Group I search (claims 1-26 & 37-39) would require use of search **Class 709, subclass 227**.

(b) Group II search (claims 27-36) would require use of search **Class 709, subclass 205**.

Newly submitted claims 27-36 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: the limitations call for determining the availability of the sender to participate in voice communication with the recipient and enabling the recipient to perceive to availability of the sender to participate in voice communication with the recipient in response to delivery of the text instant message.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 27-36 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Claims 1-26 and 37-39 are now presented for examination.

Response to Arguments

Applicant's arguments filed on 9/7/04 have been fully considered but are not persuasive. Applicant asserts, on newly amended claims, that Sekiguchi does not describe or suggest, "...enabling presentation of a text instant messaging interface that displays a received text instant message from a sender and that also be manipulated by a recipient to invoke voice communication between the sender and the recipient..." Applicant admits, "...Sekiguchi describes a system that offers chatting service and real time electronic conference (or known in the art as instant messaging; i.e., messages are sent and received by participants instantly or in real time) service that enables multiple users to communicate to each other..." Sekiguchi teaches a system that has the capability to process both text and voice instant messaging service (see fig. 1 regarding function of system 'Simultaneous Transmission of Live Speech and Data is Performed'; col. 1, lines 66 – col. 2, lines 7; users A and C (both of fig. 1) can communicate with each other through both text (via personal computer) and voice (via microphone) instant messaging). When user A (2, fig. 1) sends a text instant message (col. 13, lines 11-14) to user C (fig. 1) using the personal computer, user C receives the text message via its personal computer (6, fig. 1) and can invoke its voice instant messaging capability by responding to user A using its microphone (6B, fig. 1) to speak to user A as desired.

Regarding Morris art, Applicant asserts, "...Morris does not describe or suggest enabling presentation of a text instant messaging interface that displayed a received text instant message from a sender and that also can be manipulated by a recipient to invoke voice communication between the sender and the recipient..." Like Sekiguchi,

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Morris also teaches a system that can process both text and voice instant messaging (abstract). When client A (210, fig. 2) sends a text message to client B (202, fig. 2), client B can respond back to client A by invoking its voice instant messaging capability using its microphone (308, fig. 2) to speak to user A. The users can carry out both text and voice instant messaging simultaneously using their respective computers' interfaces (see Text Chat interface in fig. 15; page 17, lines 16-22).

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-26 and 37-79 are rejected under 35 U.S.C. 102(b) as anticipated by Sekiguchi et al, 5,848,134 (Sekiguchi hereafter).

As per claim 1, Sekiguchi teaches a communications method comprising: establishing a text instant messaging communication session between a sender (user A, fig. 1) and a recipient (user C, fig. 1) through an instant messaging host (1, fig. 1) (col. 1, lines 66 – col. 2, lines 7; col. 2, lines 57-63; user A {via computer terminal (2, fig. 1)} establishes a text instant messaging session with user B {via computer terminal (6, fig. 1)} through the instant messaging server {1, fig. 1}); facilitating a text instant message to be sent from the sender to the recipient during the session (col. 1, lines 66 – col. 2, lines 7; col. 2, lines 57-63); enabling presentation of a first text instant

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messaging interface to the recipient in which the text instant message is displayed to the recipient (col. 2, lines 57-63; col. 13, lines 12-14; users A & C (fig. 1) via terminals (2 & 6, fig. 1) can communicate with each other using either or both text/voice instant messaging); and enabling manipulation by the recipient of the first text instant messaging interface to invoke voice communication between the sender and the recipient through the instant messaging host [col. 2, lines 57-63; col. 13, lines 12-14; col. 3, lines 27; as further stated, upon receiving a text message from user A, user C can respond back by invoking its voice instant messaging 'IM' capability by speaking into its microphone {6B, fig. 1}; the voice IM response then get transmitted to user A via the instant messaging host {1, fig. 1}].

Claims 21 and 22 recite similar limitations to claim 1; therefore, they are rejected for similar reasons as claims 1 addressed above.

As per claims 2-4, Sekiguchi teaches receiving and authenticating the text instant message from the sender at the instant messaging host (col. 7, lines 46-49; instant messaging server (1, fig. 1) validates and authenticates instant messages sent between users); authenticating the text instant message comprises identifying a screen name (col. 7, lines 49-53; instant messaging server (1, fig. 1) validates and verifies usernames and passwords of users for authentication); and an IP address associated with the sender (2, fig. 1, col. 3, lines 16-18; computer (2, fig 1) has an IP address associated to it).

As per claims 5-9, Sekiguchi teaches determining hardware and software (including voice communication) capabilities of the recipient and sender (user A, C, fig.

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1) at the instant messaging host (col. 3, lines 36-41; instant messaging server stores terminal information (profile) capabilities (hardware and software) of all terminals authorized to access the system; terminals may or may not have their distinct capabilities; some terminals (2, fig. 1) are capable of sending/receiving text and voice instant messaging while others (3, fig. 1) are capable of only voice instant messaging as shown in the drawings and also discussed above).

As per claims 10-15, Sekiguchi teaches at the instant messaging host, a request to establish voice communication; the request is from the sender or recipient; authenticating the request comprise identifying screen name with a sender or recipient (col. 9, lines 38-44; instant messaging server processes and authenticates text and voice instant messaging requests from plurality of users (via usernames, passwords, etc.) as discussed above in claims 2-4).

As per claims 23-26, Sekiguchi teaches the computer readable medium is a disc and propagated signal (2, fig. 1; computer A comprise a disk to store data; computer A comprises a propagated signal when sending the signal to other devices); client device (2, fig. 1; computer A is a client device); host device (1, fig. 1; instant messaging server is host device).

Claims 37-39 are rejected for similar reasons as claim 1 addressed above.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 16-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sekiguchi in view of Morris et al, WO 00/60809 (Morris hereafter).

As per claims 16-20, Sekiguchi teaches enabling voice communication comprises establishing a generic signaling interface channel, a control channel, and an audio channel between the sender and the recipient [col. 2, lines 57-63; col. 3, lines 6-9 & 16-22 & 25-27; in establishing a text and voice instant messaging session between the participants, it's inherent that these channels are used to set up and process the transactions between the participants; furthermore, it would have been obvious to one of ordinary skill in the art to use these channels in a text/voice instant messaging session as disclosed by Morris in a related art to the claimed invention. Morris discloses an audio/text (data and voice instant messaging) conferencing system that comprise communication module (or control channel), interface module (or interface channel), and audio module (or audio channel) {406, fig. 6, page 11, lines 4-6}; UDP test on the audio channel; control channel comprises a TCP/IP socket; audio channel comprises a UDP channel or TCP channel (all inherent components of Sekiguchi teachings; or see Morris teachings in fig. 5A, page 9, lines 19-23).

Conclusion

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jack P Nguyen whose telephone number is (571) 272-3945. The examiner can normally be reached on M-F 8:30-5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenton Burgess can be reached on (571) 272-3949. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

jpn



Dung C. Dinh
Primary Examiner